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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,628	03/23/2001	Frank Venegas JR.	IDS-11605/14	4648 ⁷

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EXAMINER

FLANDRO, RYAN M

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 01/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/815,628

Applicant(s)

VENEGAS, FRANK

Examiner

Ryan M Flandro

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-8, 15-21 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 4, 16 and 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8, 15, 17 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

2. Claims 17, 5, 6, 8, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venegas, Jr. (US 5,396,739) (Venegas I) in view of Venegas, Jr. et al (US 5,364,077) (Venegas II).

- a. Claim 17. Venegas I shows and discloses a handrail assembly **10** with an infill panel **40**, comprising a pair of spaced apart vertical posts **12,16** each having a lower end and an upper end, the lower ends being configured to engage a support surface **48**, each of the posts **12,16** having a height and an outside diameter; replaceable polymerized sheathing **14,18** surrounding each of the posts **12,16**, the sheathing **14,18** having an inner diameter equal to or greater than the outside diameter of the posts **12,16**, the sheathing **14,18** extending substantially the entire height of the posts **12,16**; an upper rail **22** extending between the upper ends of the vertical posts **12,16** and engaged to the upper ends of the vertical posts **12,16**, the upper rail **22** having a length and an outside diameter; a lower rail **26** extending between the vertical posts **12,16** and positioned below the upper rail **22**, the lower rail **26** engaged to the vertical posts **12,16** and having a length and an outside diameter; replaceable polymerized sheathing **24,28** surrounding each of the rails **22,26**, the sheathing **24,28** having an inner diameter equal to or greater than the outside diameter of the rails **22,26**, the sheathing **24,28** extending substantially the entire length

of the rails **22,26**; the vertical posts **12,16** and the rails **22,26** together defining a perimeter frame having a framed area **30** defined therein, the framed area **30** having a top edge defined by the upper rail **22**, a lower edge defined by the lower rail **26**, and sides defined by the vertical posts **12,16**; and an infill panel **40** supported in the framed area **30** (see figures 1-3; columns 2-3) .

i. Venegas I does not disclose that the rails are releasably engaged to the posts.

ii. Venegas II, however, teaches rails **58, 50, 42** being releasably engaged to vertical posts **22** in order to facilitate easy disassemblage and removal of the handrail assembly from one location and easy assemblage and installation in another location (see column 1 lines 35-45).

iii. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made modify the handrail assembly of Venegas I to include releasable engagement between the rail and post members, for the purpose of facilitating removal and installation of said assembly in distinct locations as taught by Venegas II. Additionally, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.

Nerwin v. Erlichman, 168 USPQ 177, 179 (BdPatApp&Int 1969).

b. Claim 5. The combination of Venegas I and Venegas II includes the infill panel **40** having an area which substantially consumes the framed area **30**; the panel **40** being mounted in the framed area **30** (see Venegas I figure 1).

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- c. Claim 6. The combination of Venegas I and Venegas II includes one or more sections of U-channel **32** affixed to each of the vertical posts **12,16** and the rails **22,26** for mounting the infill panel **40** (see Venegas I figures 1-3; column 2 lines 50-54).
- d. Claim 8. The combination of Venegas I and Venegas II further includes the infill panel **40** being a solid panel (see Venegas I figures 1-3).
- e. Claim 25. The combination of Venegas I and Venegas II includes each of the horizontal rails **22,26** and the vertical posts **12,16** comprising substantially straight members and the polymerized sheathing **14,18,24,28** is substantially straight (see Venegas I figures 1-3).

3. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Venegas I and Venegas II, as applied to claim 5 above, further in view of Parisien (US 5,474,279). Venegas I, as modified by Venegas II, includes an infill panel, but does not explicitly disclose that the infill panel is a mesh screen. Parisien, however, teaches (abstract, lines 1-3) that mesh screens and solid infill panels are considered art recognized equivalents within the ordinary skill of the art (i.e., within the art of fence, barrier, or partition systems). Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the hand rail assembly of the combination of Venegas I and Venegas II to incorporate a mesh screen since mesh screens and solid infill panels are considered art recognized equivalents as demonstrated by Parisien.

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4. Claims 17 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Venegas, Jr. (US 5,396,739) (Venegas I) in view of Bobrowski (US 3,342,457).

a. Claim 17. Venegas I shows and discloses a handrail assembly **10** with an infill panel **40**, comprising a pair of spaced apart vertical posts **12,16** each having a lower end and an upper end, the lower ends being configured to engage a support surface **48**, each of the posts **12,16** having a height and an outside diameter; replaceable polymerized sheathing **14,18** surrounding each of the posts **12,16**, the sheathing **14,18** having an inner diameter equal to or greater than the outside diameter of the posts **12,16**, the sheathing **14,18** extending substantially the entire height of the posts **12,16**; an upper rail **22** extending between the upper ends of the vertical posts **12,16** and engaged to the upper ends of the vertical posts **12,16**, the upper rail **22** having a length and an outside diameter; a lower rail **26** extending between the vertical posts **12,16** and positioned below the upper rail **22**, the lower rail **26** engaged to the vertical posts **12,16** and having a length and an outside diameter; replaceable polymerized sheathing **24,28** surrounding each of the rails **22,26**, the sheathing **24,28** having an inner diameter equal to or greater than the outside diameter of the rails **22,26**, the sheathing **24,28** extending substantially the entire length of the rails **22,26**; the vertical posts **12,16** and the rails **22,26** together defining a perimeter frame having a framed area **30** defined therein, the framed area **30** having a top edge defined by the upper rail **22**, a lower edge defined by the lower rail **26**, and sides defined by the vertical posts **12,16**; and an infill panel **40** supported in the framed area **30** (see figures 1-3; columns 2-3).

iv. Venegas I does not disclose that the rails are releasably engaged to the posts.

v. Bobrowski, however, teaches rails **24,26** being releasably engaged to vertical posts **20,20'** in order to facilitate easy assemblage and disassemblage of the guardrail assembly **10** and provide a high degree of adjustability and flexibility in size and style of the guardrail assembly 10 (see column 1 lines 13-21; column 2 lines 5-6) .

vi. Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made modify the handrail assembly of Venegas I to include releasable engagement between the rail and post members, for the purpose of facilitating adjustability and flexibility of said assembly as taught by Bobrowski. Additionally, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179 (BdPatApp&Int 1969).

b. Claim 15. The combination of Venegas I and Bobrowski, as applied to claim 17, includes structural fittings **30,32,34** interconnecting the rails **24,26** with the posts **20,20'** (Bobrowski figures 1-4; columns 1-3), at least one of the structural fittings **30,32,34** comprising a slip-on fitting (see Bobrowski column 2 lines 5-6). The combination lacks disclosure that the inner diameter of the slip-on structural fittings is greater than or equal to the outer diameter of the plastic sheathing on the posts or rails. Specifically, Bobrowski teaches slip-on fittings that are rectangular in cross-section and, therefore, do not have inner diameters. Nevertheless, a change in the shape of a prior art device is a

design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). It would have been obvious, then, to modify the rectangular slip-on fittings of Bobrowski to instead be circular in cross-section for accepting a round post or rail. Further, in order to connect the polymer sheathed rails and posts of Venegas I according to the teaching of Bobrowski, the inner diameter of the slip-on fittings would have to be greater than or equal to the outer diameter of the plastic sheathing on the posts or rails. Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the handrail system of the combination of Venegas I and Bobrowski to include slip-on fittings with inner diameters greater than or equal to the outer diameter of the plastic sheathing on the posts or rails.

Response to Arguments

5. Applicant's arguments filed 3 December 2003 have been fully considered but they are not persuasive.
 - a. First, in response to applicant's argument that there is no suggestion to combine Venegas I and Venegas II, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Venegas II is cited to teach releasable engagement between the posts and the rails for

purposes of installation *and/or* disassembly. Moreover, Venegas I discloses the rails and posts as one piece but does not explicitly teach away from releasably attaching the posts and the rails as argued by applicant. The references, when viewed together by one of ordinary skill in the art, teach each limitation recited in the rejected claims and the required motivation is indeed provided by Venegas II as set forth above.

b. Applicant further argues that “Venegas I had no intention of disassembling the guard rail and putting it someplace else.” This argument would be particularly relevant had the Examiner rejected the claims under 35 USC §102. The claims were, however, rejected under 35 USC 103. The “intention” of Venegas I is not defeated by providing releasable connections between the posts and rails as taught by Venegas II, at least in terms of providing for installation of the assembly. Thus, even assuming, *arguendo*, that Venegas I explicitly precluded disassembly, his invention still allows for at least an initial installation wherein, according to the teachings of Venegas II, installation assembly is made easier by releasable attachment between the posts and rails. Additionally, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179 (BdPatApp&Int 1969). This is, undoubtedly, the case here.

c. Applicant’s arguments regarding the rejections under Venegas I in view of Bobrowski mirror those set forth above and are thus unpersuasive for the same reasons.

Conclusion


6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan M Flandro whose telephone number is (703) 305-6952. The examiner can normally be reached on 8:30am - 5:30pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on (703) 308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

RMF
January 25, 2004


Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3670